



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/639,825 | 08/17/2000 | Michael Chen | AVI007 | 4926 |

27765 7590 12/17/2003

NAIPO (NORTH AMERICA INTERNATIONAL PATENT OFFICE)
P.O. BOX 506
MERRIFIELD, VA 22116

| EXAMINER |
|----------|
|----------|

GIBBS, HEATHER D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2622

DATE MAILED: 12/17/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/639,825

Applicant(s)

CHEN, MICHAEL

Examiner

Heather D Gibbs

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2622

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 11/12/2003 and has been entered and made of record. Currently, claims 1-8 are pending.

Response to Arguments

2. Applicant's arguments have been fully considered but they are not persuasive. Applicant argues that neither Hayakawa nor Shih teach directly transmitting image data to a portable external storage device without the need of a host to control image data transmission. Upon further consideration, the Examiner finds that in Col 4 Lines 46-49, Hayakawa teaches of the option of data being transmitted without the host. If the switch is not pressed within a predetermined time, the image scanner transmits the previous drawing. The image data can be displayed and reviewed to select whether to store a particular scanned image and whether to transfer a stored image. In Column 3 Lines 1-26, Shih teaches of transmitting image signals to an electric device 64 directly by using a circuit control program 78. The argument is not persuasive in that the system of Hayakawa is controlled by external portion 22. This action initiates data communication and the image data is displayed on the screen of EITHER the personal computer 21 or word processor 23. See Col 3 Lines 43-55.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

Art Unit: 2622

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1,4,5 are rejected under 35 U.S.C. 102(b) as being anticipated by Hayakawa et al (US 5,550, 938).

Hayakawa teaches of a scanner comprising: a casing 1a; a scanning module installed inside the casing for scanning a document and generating corresponding image data (Col 4 Lines 19-60); a control unit 52 installed in the casing 1a, the control unit 52 comprising at least a memory for storing a control program and the image data generated from the scanning module, and a processor 52 for executing the control program to control the operations of the scanner (Col 2 Lines 64-67 and Col 3 Lines 1-12); and an output port installed on the casing and electrically connected to the control unit for connecting a portable storage device disposed outside the casing of the scanner (Fig 11-connection with host computer); wherein when the scanning module finished scanning a document, the control unit converts the image data of the document according to the type of storage device that is connected to the output port and then transmits the image data converted by the control unit to the storage device (Col 3 Lines 43-55 and Fig 4).

Regarding claim 4, Hayakawa teaches wherein the scanner further comprises a connecting port installed on the casing and electrically connected to the control unit for connecting to a computer, and when the scanning module finished scanning the document, the control unit transmits the image data of the document to the computer for further processing via the connecting port (Col 3 Lines 43-55 and Fig 4).

Regarding claim 5, Hayakawa teaches wherein the portable storage device is a hard drive, or a floppy drive or a writ able optical drive (Col 3 Lines 43-55 and Fig 4).

Art Unit: 2622

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-3,6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayakawa et al (US 5,550,938) in view of Shih (US 6,504,626).

Considering claim 2, Hayakawa teaches of the scanner as disclosed above in claim 1 but fails to particularly point out wherein the output port is connected to a printer, and when the scanning module finishes scanning a document, the control unit prints out the image data of the document via the printer.

Shih discloses a scanner wherein the output port is connected to a printer, and when the scanning module finishes scanning a document, the control unit prints out the image data of the document via the printer (Col 3 Lines 9-26).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the output port of Shih in the scanner of Hayakawa. Hayakawa's scanner would easily be modified to include an output port for a printer since it already has features that support a connection with an external device.

Regarding claim 3, Hayakawa teaches of a scanner as discussed above wherein the control program first identifies the type of storage device connected to the output port, and then controls the transmission of the image data of the document according to the said type (Col 3 Lines 43-55).

Art Unit: 2622

The type of (storage) device is recognized when the scanner is inserted in the card insertion portion of disc driver 22. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a driver for a printer. Hayakawa's scanner would easily be modified to include a control program that identifies the electronically connected printer.

Regarding claim 6, Hayakawa teaches of a scanner comprising: a casing 1a; a scanning module installed inside the casing for scanning a document and generating corresponding image data (Col 4 Lines 19-60); a control unit 52 installed in the casing 1a, the control unit 52 comprising at least a memory for storing a control program and the image data generated from the scanning module, and a processor 52 for executing the control program to control the operations of the scanner (Col 2 Lines 64-67 and Col 3 Lines 1-12); and an output port installed on the casing and electrically connected to the control unit for connecting a portable storage device disposed outside the casing of the scanner (Fig 11-connection with host computer); wherein when the scanning module finished scanning a document, the control unit converts the image data of the document according to the type of storage device that is connected to the output port and then transmits the image data converted by the control unit to the storage device (Col 3 Lines 43-55 and Fig 4).

Hayakawa does not specifically teach of a printer port electrically connected to the control unit for connecting to an external printer and converting the image data of the document and then transmitting the image data converted by the control unit to the printer via the printer port for printing.

Art Unit: 2622

Shih discloses a scanner wherein the output port is connected to a printer, and when the scanning module finishes scanning a document, the control unit prints out the image data of the document via the printer (Col 3 Lines 9-26).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the output port of Shih in the scanner of Hayakawa. Hayakawa's scanner would easily be modified to include an output port for a printer since it already has features that support a connection with an external device.

Regarding claim 7, Hayakawa teaches wherein the scanner further comprises a connecting port installed on the casing and electrically connected to the control unit for connecting to a computer, and when the scanning module finishes scanning the document, the control unit transmits the image data of the document to the computer for further processing via the connecting port (Col 3 Lines 43-55 and Fig 4).

Considering claim 8, Hayakawa teaches wherein the portable storage device 22 is a hard drive or a floppy drive or a writ able optical drive (Col 3 Lines 43-55 and Fig 4).

Conclusion

3. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no

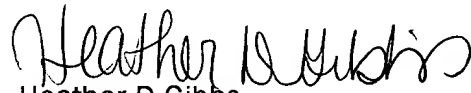
Art Unit: 2622

event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heather D Gibbs whose telephone number is 703-306-4152. The examiner can normally be reached on M-F 8AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703-305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.


Heather D Gibbs
Examiner
Art Unit 2622

hdg


EDWARD COLES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600